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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,127	01/28/2004	Wayne W. Fan	56978US007	2119
32692	7590	11/18/2005	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			HU, HENRY S	
			ART UNIT	PAPER NUMBER
			1713	
DATE MAILED: 11/18/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,127

Applicant(s)

FAN ET AL.

Examiner

Henry S. Hu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on IDS of July 12, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7-12-2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. It is noted that this application 10/766,127 is a **DIV of 09/938,188, which is now US Patent No. 6,689,854**. In a close examination on current DIV application being rewritten from original dependent Claims 12-17, the Applicants have already corrected the informalities as previously pointed out by the Examiner in the parent case. However, **the originally non-elected Group II (Claims 12-17) has been rejoined with the elected Group I (Claims 1-11 and 18) for allowance.**

2. Since all claims previously withdrawn from consideration under 37 CFR 1.142 have been rejoined, the restriction requirement made in Paper No. 5 dated January 13, 2003 was hereby withdrawn by the Examiner (see Notice of Allowability on September, 2003). **Claims 1-16 are now pending with only one independent claim (Claim 1).** An action follows.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The

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filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. **Claims 1-16 are rejected under 35 U.S.C. 101 as claiming the same invention as that of Claims 13-18 of US Patent No. 6,689,854 to Fan et al. (with application # 09/938,188 and a priority date 8-23-2001).** This is a double patenting rejection since the conflicting claims have in fact been patented.

5. **Parent Claim 1 and its dependent Claims 2-16** of present invention relate to “a method for rendering a porous substrate repellent to water and/or oil-based stains” and it carries two continuous steps by making and using a specified copolymer with repeating units from monomers (a), (b) and (c) with the optional use of monomer (d). In a close examination, parent **Claim 1** of present invention relates to make and to use an aqueous fluorine-containing polymeric composition comprising polymers carrying the language of “**fluoroaliphatic moiety**” for (a), “**alkoxysilane moiety**” for (c), and “**non-hydrophilic group**” for (d). The key point is that monomer (c) is related to an alkoxysilane-containing acrylate, acrylamide or thioacrylate, while the claimed optional monomer (d) must be non-hydrophilic.

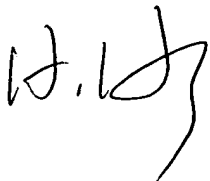
6. As discussed above, current application is a **DIV** case and is rewritten from its original and allowed dependent Claims 12-17. In a close examination on current Claims 1-16, they are exactly the same as original Claims 12-17 and thereby are in the same scope of parent case. The key point is that **the originally non-elected Group II (Claims 12-17) has already been rejoined with the elected Group I (Claims 1-11 and 18) for allowance at that time.** In

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summary, current Claims 1-16 are the same as Claims 13-18 (the original Claims 12-17) of the allowed case. This Application needs to be amended or abandoned according to MPEP.

7. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Dr. Henry S. Hu** whose telephone number is **(571) 272-1103**. The examiner can be reached on Monday through Friday from 9:00 AM –5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The fax number for the organization where this application or proceeding is assigned is **(571) 273-8300** for all regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Henry S. Hu

Patent Examiner, Art Unit 1713, USPTO

November 11, 2005



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